

REMARKS/ARGUMENTS

Reconsideration of the present application is respectfully requested. Claim 1, 3, 12, 13, 15, 23 and 29 have been amended. Claims 2, 14, 27 and 28 have been canceled. Claims 1, 3-13, 15-26 and 29-30 remain pending.

A Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address and a Statement Under 37 CFR 3.73(b) were filed on March 8, 2007. Accordingly, Applicant requests the attorney docket number associated with the present application be changed from MICR0424 to MFCP.132805.

Applicant thanks Examiner Bonshock for the courtesy of a telephone interview with Applicant's representative Patrick Lujin on March 2, 2007. Agreement was not reached during the interview with respect to potential claim amendments in light of the cited prior art. However, the interview has served to expedite prosecution in that Applicant has amended the pending independent claims after careful consideration of Examiner Bonshock's comments during the interview.

Rejections based on 35 U.S.C. § 112

Claims 15-18 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Office Action notes there is insufficient antecedent basis for "the plurality of categories" limitation of claim 15. Claims 16-18 depend directly or indirectly from dependent claim 15, and claim 15 depends from independent claim 13. Independent claim 13 has been amended to recite "a plurality of categories." Applicant submits that this amendment overcomes the rejection of claims 15-18 under § 112 because there is now sufficient antecedent basis for "the plurality of categories" limitation of claim 15.

Claim Objections

The Office Action objects to the use of (a)-(c) in dependent claims 2-3 and 14-15 given that (a)-(d) have already been used in independent claims 1 and 13. Dependent claims 2 and 14 have been canceled, and independent claims 1 and 13 have been amended to include the subject matter of claims 2 and 14, respectively, without reusing (a)-(c). Dependent claims 3 and 15 have been amended to eliminate the use of (a)-(c). Applicant submits that these claim amendments overcome the claim objections noted in the Office Action with respect to claims 1-3 and 13-15.

Rejections based on 35 U.S.C. § 102

Claims 1, 7-11, 13, 15-17, 19-27 and 29-30 stand rejected under § 102(e) as being anticipated by U.S. Patent Publication No. US 2004/0010513 A1 to Scherr et al. ("Scherr"). Applicant has amended independent claims 1, 13 and 23 to recite features that the Office Action admits are not disclosed in Scherr.

As amended, independent claims 1 and 13 incorporate limitations from dependent claims 2 and 14, respectively, and Scherr "doesn't specifically teach displaying a plurality of categories of entities for association with items in the list." *See* Office Action at pp. 9-10. As noted at page 3 of Applicant's specification, enabling "a user to associate an entity such as a task or template, a document, or a Web link with a selected item in the list of to do items" is one of the "more powerful functions of the present invention," especially since "the user can readily access the entity from within the integral user environment" once the entity "has thus been associated with the item."

Amended independent claim 23 incorporates subject matter from dependent claim 28, which was the subject of a § 103 rejection. *See* Office Action at pp. 8-9.

The amendments to independent claims 1, 13 and 23 also affect dependent claims 7-11, 15-17, 19-26 and 29-30, and dependent claim 27 has been canceled. Consequently, Applicant respectfully submits that the rejection of claims 1, 7-11, 13, 15-17, 19-27 and 29-30 under § 102(e) are now moot and should be withdrawn.

Rejections based on 35 U.S.C. § 103 over Scherr and Zawadzki

Claims 2-6, 12 and 14 stand rejected under § 103(a) as being unpatentable over Scherr and U.S. Patent No. 7,107,268 to Zawadzki et al. (“Zawadzki”). Claims 2 and 14 have been canceled, so the rejection of those claims is now moot and should be withdrawn. Applicant respectfully traverses the rejection of remaining claims 3-6 and 12 under § 103(a).

Claims 3-6 and 12 are patentable for at least the reason that they depend from a base claim, independent claim 1, that is patentable over the prior art of record. As noted above, claim 1 was amended to include the limitations of claim 2, which are not disclosed in Scherr. The Office Action asserts that the missing disclosure can be found at column 34, lines 1-47 and Figure 17 of Zawadzki. *See* Office Action at p. 10. However, the cited portion of Zawadzki fails to teach “displaying a plurality of categories of entities . . . for association with a to do item in the list” as required by amended claim 1. Rather, column 34 of Zawadzki merely describes how to navigate a project tree structure that may include to do items and how to add items to the project tree structure. In Zawadzki, the “items” in the project tree structure are “associated with that Project,” but that does not meet the claim limitation, which requires displaying a plurality of categories of such items *for association with a to do item*. Thus, claims 3-6 and 12 are patentable over the combination of Scherr and Zawadzki for at least the reason that they depend directly or indirectly from amended claim 1, which is patentable over the prior art of record.

Furthermore, claims 3-6 and 12 add further limitations to claim 1 and are patentable over the prior art of record on this additional ground. For example, claim 6 recites “including a blank entity among the plurality of choices that are displayed to the user” and is thus separately patentable over the prior art of record for the same reasons discussed below in connection with claim 18.

Rejections based on 35 U.S.C. § 103 over Scherr

Claims 18 and 28 stand rejected under § 103(a) as being unpatentable over Scherr. The limitations of claim 28 have been incorporated into independent claim 23, and claim 28 has been canceled.

With respect to the rejection of claim 18 over Scherr, the Office Action cites to paragraphs 35 and 42 of Scherr and asserts that “it would be obvious to link to blank entities.” *See* Office Action at p. 8. Moreover, the Office Action indicates that one skilled in the art would be motivated to link to blank entities “because a blank document is just an empty document (empty word processing document), that would provide a user with a starting point for a document.” *Id.* As implied by the Office Action, the limitation in claim 18 of including “a blank entity among the plurality of choices that are displayed to a user” is not disclosed in Scherr. Paragraph 35 of Scherr merely discusses contextualizing “messages, whether sent via e-mail, telephone, instant messaging, or the like.” It does not contemplate “blank” messages. Paragraph 42 of Scherr builds on paragraph 35 in that it discusses contextualizing “other information, such as word processing documents, spreadsheets, web pages, databases, presentations and the like.” As with paragraph 35, “blank” documents are not contemplated by paragraph 42. Therefore, the Office Action appears to be taking Official Notice that “it would be obvious to link to blank entities.” Similarly, the Office Action appears to be taking Official Notice of the motivation to

modify Scherr to arrive at the subject matter of claim 18. Applicant submits that the subject matter of claim 18 is not obvious in light of Scherr and respectfully requests withdrawal of the rejection or citation to *specific prior art* that discloses the claimed subject matter. To establish a *prima facie* case of obviousness, Official Notice unsupported by documentary evidence should only be taken where the facts asserted to be well known, or to be common knowledge in the art, are capable of instant and unquestionable demonstration as being well-known. See MPEP § 2144.03(A). If Applicant challenges a factual assertion as not properly officially noticed or not properly based on common knowledge, the Examiner must support the factual assertion with adequate evidence. See MPEP § 2144.03(C). Moreover, Applicant respectfully requests identification of a motivation *from the prior art* to modify Scherr. For at least the reasons stated above, claim 18 is patentable over Scherr.

It should also be noted that claim 18 is patentable by virtue of its dependency from one or more claims (*e.g.*, claim 13) that are patentable over the prior art of record. As noted above, claim 13 was amended to include the limitations of claim 14, which are not disclosed in Scherr. The Office Action asserts that the missing disclosure can be found at column 34, lines 1-47 and Figure 17 of Zawadzki. See Office Action at p. 10. However, the cited portion of Zawadzki fails to teach “presenting a plurality of categories of entities . . . for association with a to do item in the list” as required by amended claim 13. Rather, column 34 of Zawadzki merely describes how to navigate a project tree structure that may include to do items and how to add items to the project tree structure. In Zawadzki, the “items” in the project tree structure are “associated with that Project,” but that does not meet the claim limitation, which requires presenting a plurality of categories of such items *for association with a to do item*. Thus, claim 18 is patentable over the combination of Scherr and Zawadzki for the additional

reason that it depends from amended base claim 13, which is patentable over the prior art of record.

Although claim 28 has been canceled, the limitations of claims 27 and 28 have been incorporated into independent claim 23, and amended claim 23 is patentable over Scherr. In explaining the rejection of claim 28, the Office Action cited to paragraph 42 of Scherr as teaching “implementing a ‘file system search’, which obviously could comprise a natural word query, of documents.” See Office Action at p. 10. Even if this were true, it falls well short of the claimed invention. Amended claim 23 and original claim 28 both require the search to be performed *automatically* and to be “a natural word query *based on the currently selected item in the to do list*” (emphasis added). By contrast, paragraph 42 of Scherr merely states: “Moreover, the file systems search, access control, and security tools can be used, intact, to compliment the capabilities of the present invention.” Paragraph 42 of Scherr does not teach searching automatically, does not teach a natural word query, and does not teach basing the natural word query on a currently selected item in a to do list. Thus, amended claim 23 is patentable over Scherr.

As explained above, independent claims 1, 13 and 23 are each patentable over the prior art of record. For at least this reason, the pending dependent claims are also patentable over the prior art of record. Many of the pending dependent claims are also separately patentable over the prior art of record as explained above.

CONCLUSION

For the reasons stated above, claims 1, 3-13, 15-26 and 29-30 are now in condition for allowance. Applicant respectfully requests withdrawal of the pending rejections and allowance of claims 1, 3-13, 15-26 and 29-30. If any issues remain that would prevent

issuance of this application, the Examiner is urged to contact the undersigned by telephone prior to issuing a subsequent action. The Commissioner is hereby authorized to charge any additional amount required (or to credit any overpayment) to Deposit Account No. 19-2112.

Respectfully submitted,

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